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KONRAD RAYNES & VICTOR, LLP  
315 S. BEVERLY DRIVE  
# 210  
BEVERLY HILLS, CA 90212

EXAMINER

DINH, KHANH Q

ART UNIT

PAPER NUMBER

2151

DATE MAILED: 05/20/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/533,498

Applicant(s)

KIRKEBY, KEVIN WAYNE

Examiner

Khanh Dinh

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 3/9/2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-30 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 4, 14, 24 is/are allowed.
- 6) ☒ Claim(s) 1-3, 5-13, 15-23 and 25-30 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: \_\_\_\_\_

**DETAILED ACTION**

1. This is in response to the Amendment filed on 3/9/2004 (paper # 14). Claims 1-30 are presented for examination.

**Claim Rejections - 35 USC § 102**

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) do not apply to the examination of this application as the application being examined was not (1) filed on or after November 29, 2000, or (2) voluntarily published under 35 U.S.C. 122(b). Therefore, this application is examined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

3. Claims 1-3, 5-13, 15-23 and 25-30 are rejected under 35 U.S.C. 102(e) as being anticipated by Freeman, US pat. No.6,020,980.

As to claim 1, Freeman discloses a method for processing a message in a network computing system including a facsimile transmission comprised of a recipient contact address and message content (i.e., email address associated with a telephone number and a subscriber, see fig.3B and col.6 lines 9-29), wherein the message content includes at least one of message text and attached files, comprising:

managing with the facsimile server (server 132 fig.1) the facsimile transmissions as jobs (customer requests), transferring with the facsimile server (112 fig.1) the message content to a conversion computer (fax server 122 fig.1); maintaining, with the conversion computer, different attachment files in different file formats to images in an image file format (i.e., converting native facsimile objects files to standard bit maps, see fig.1 and col.6 line 50 to col.7 line 55), wherein a plurality of the application programs are capable of converting files in different file formats to the image file format and launching, with the conversion computer, at least one application program to convert image message content in a image file format (i.e., reformatting facsimile transmission formats into subscriber's selected formats including image , see abstract, fig. 1, col.6 line 30 to col.7 line 44).

transferring, with the conversion computer (122 fig.1), the converted message content to the facsimile server (132 fig.1) and transferring, with the facsimile server, the converted message content in the image file format to a communication port for transmittal to the recipient contact address (Clients 134, 136, 138 fig.1) (see col.8 line 7 to col.9 line 59 and col.10 lines 6-60).

As to claim 2, Freeman discloses transferring, with the facsimile server, a job number (facsimile number) assigned to the fax job to the conversion computer; and requesting, with the conversion computer, the message content for the job number, wherein the facsimile server transfers the message content in response to receiving the request from the conversion computer (see col.8 line 37 to col.9 line 59 and col.12 lines 7-67).

As to claim 3, Freeman discloses maintaining with the facsimile server, a job table (table 1, col.8 lines 52-58) fax job records identified by job number and changing, with facsimile server, state fields in the fax job records to manage the workflow of the fax jobs between conversion computer, conversion computer and communication port (using the facsimile server to perform the file translation and then compress the reformatted file for faster transmission to e-mail system, see also fig.2, col.8 line 37 to col.9 line 59 and col.12 lines 7-67).

As to claim 5, Freeman discloses the message content is converted to one or more images in the image file format (reformatting facsimile transmission into subscriber selected computer file formats and for reformatted files to e-mail system, see fig.2, col.7 line 45 to col.8 line 59).

As to claim 6, Freeman discloses determining one of multiple application programs capable of opening the attachment file and using the determined application

program to convert the content of the attachment file to one or more images in the image file format, wherein all the images in the file format comprising the at least one converted attachment file are transferred to the facsimile server (see fig.2, col.8 line 37 to col.9 line 59 and col.12 lines 7-67).

As to claim 7, Freeman discloses converting, with the conversion computer, the message text to at least one image in the file format, wherein the images comprising the converted attachment files are arranged in a file in the file format according to an order in which they were attached to the message and follow one image comprising the converted message text (see figs. 2, 3, col.8 line 37 to col.9 line 59 and col.12 lines 7-67).

As to claim 8, Freeman discloses maintaining, with the conversion computer, multiple application programs open to concurrently convert the content of different attachment files to images in the file format (see figs. 2, 3, col.8 line 37 to col.9 line 59 and col.12 lines 7-67).

As to claim 9, Freeman discloses that the different attachment files concurrently converted to images in the file format are part of different fax jobs (see figs. 2, 3, col.8 line 37 to col.9 line 59, col.10 lines 6-60 and col.12 lines 7-67).

As to claim 10, Freeman discloses one application program to concurrently convert the content of a different attachment files associated with the application program to images in the image file format (see figs. 2, 3, col.8 line 37 to col.9 line 59, col.10 lines 6-60 and col.12 lines 7-67).

As to claim 11, Freeman discloses a network computing system for processing a message including a facsimile transaction comprising of a recipient contact address and message content (i.e., email address associated with a telephone number and a subscriber, see fig.3B and col.6 lines 9-29), wherein the message content includes at least one of message text and attached files, comprising:

(a) a facsimile server (132 fig.1). It is inherent that a facsimile server, which is a computer terminal, has a processor and a memory to process data information.

(b) a conversion computer (fax server 122 fig.1) comprising a second memory (126 fig.1) and a communication port (116 fig.1) in communication with the facsimile server (see fig. 1, see abstract, col.6 line 9 to col.7 line 56). It is inherent that a fax server which has a processor to process data information

(c) first program logic residing in the first memory, wherein the first program logic, when read and executed by the first processor performs (see col.7 lines 11-56) for managing the facsimile transmission as a fax job, transferring the message content to a second computing system and transferring the message content received from the second computing system to a communication port for transmittal to the recipient contact address (see fig.2, col.7 line 57 to col.8 line 59).

(d) second program logic residing in the second memory, wherein the second program logic, when read and executed by the second processor performing of launching at least one application program to convert (reformat the message) the message content to at least one image in a file format and transferring the converted message content in the file format to the facsimile server (132 fig.1) (see col.8 line 7 to col.9 line 59 and col.10 lines 6-60).

Claims 12, 13, 15-20 are rejected for the same reasons set forth in claims 2, 3, 5-10 respectively.

Claim 21 is rejected for the same reasons set forth in claim 1. As to the added limitation, Freeman further discloses transferring the message content received from the second computer to a communication port for transmittal to the recipient contact address (see col.8 line 37 to col.9 line 59 and col.12 lines 7-67).

Claims 22, 23, 25-30 are rejected for the same reasons set forth in claims 2, 3, 5-10 respectively.

### ***Response to Arguments***

4. Applicant's arguments filed 1-3, 5-13, 15-23 and 25-30 have been fully considered but they are not persuasive.

\* Applicant asserts that the cited reference does not disclose that the cited server that converts the fax sending the content back to the terminal.



*The Applicant's argument is not persuasive. Examiner respectfully points out that Freeman still discloses that a server (122 fig.1) that converts the fax sending the content back to the terminal (clients 134, 136, 138 fig.1) (using server 132 fig.1 to perform the file translation and then compress the reformatted file for faster transmission to e-mail system and then transferring back to clients) as rejected above. Applicant is advised that they are responsible for the entire content and relevant passages other than those cited by the Examiner should be addressed accordingly.*

\*Applicant further asserts that the cited reference does not disclose maintaining multiple application programs to convert content from different attachment files to an image file format.

*Examiner respectfully point out that Freeman discloses a facsimile server (122 fig.1) for receiving facsimile transactions and for reformatting/translating facsimile transmissions into subscriber formats. Moreover, Freeman discloses that the subscriber's formats is a graphical file format (see fig.2, 3, col.8 line 37 to col.9 line 59 and col.12 lines 7-67). For example, users of the different email systems can use different application programs to convert attachment files into the desired/appropriate formats depending on the request of a service provider in a communications network.*

*Therefore, the examiner asserts that cited prior art teaches or suggests the subject matter broadly recited in independent claims 1, 11 and 21.*

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*Claims 2, 3, 5-10, 12, 13, 15-20, 22, 23, 25-30 are also rejected at least by virtue of their dependency on independent claims and by other reasons set forth in the previous office action [see paper no. 13]. Accordingly, claims 1-3, 5-13, 15-23 and 25-30 are respectfully rejected.*

### Conclusion

5. Claims 1-3, 5-13, 15-23 and 25-30 are **rejected**.
6. Claims 4, 14 and 24 are *allowed*.
7. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Khanh Dinh whose telephone number is (703)

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308-8528. The examiner can normally be reached on Monday through Friday from 8:00 A.m. to 5:00 P.m.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Glenton Burgess, can be reached on (703) 305-4792. The fax phone numbers for this group is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 305 -9600.



**FRANTZ B. JEAN**  
**PRIMARY EXAMINER**

Khanh Dinh  
Patent Examiner  
Art Unit 2151  
5/14/2004